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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,880	01/31/2001	Marc John Payne	01435.0106	2061
22852	7590	12/17/2004	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			LAVILLA, MICHAEL E	
			ART UNIT	PAPER NUMBER
			1775	

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/772,880

Applicant(s)

PAYNE, MARC JOHN

Examiner

Michael La Villa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20041004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4 October 2004 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
 1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimberley et al. WO 99/46303 in view of Chang EPA 0 323 716 for the reasons of record in the Office Action mailed on 2 April 2004.

Response to Amendment

5. In view of applicant's amendments and arguments, applicant traverses the section 103 rejection over Kimberley in view of Chang of the Office Action mailed on 2 April 2004.
6. Applicant's attention is drawn to page 10, line 13 of Kimberley where Kimberley teaches that "catalysts can be formed in situ in the presence of support materials". This teaching that catalysts may be formed in situ encompasses forming alumoxane materials in situ in the presence of support as the alumoxane material of Kimberley is a component of the catalyst system of Kimberley. At lines 14 and 15 of page 10, Kimberley teaches that catalyst components may be added sequentially. Chang teaches how alumoxane materials are formed in situ by adding alkylaluminum compounds to hydrated support materials in order to form a support having alumoxane co-catalyst.
7. The rejection explains that using the in situ method of making alumoxanes of Chang to perform the in situ method of making catalyst components as suggested by Kimberley would have been obvious. Kimberley suggests making alumoxane activator in situ and Chang teaches how to make alumoxane activator in situ in the presence of hydrated support. That the catalysts of Chang are metallocene-based does not render the combination of teachings inappropriate.

Kimberley teaches at page 10, line 8 that metallocene catalysts may be used in the method of Kimberley. There is no basis for believing that the alumoxane formed materials by the in situ method of Chang would be unsuitable for the catalysts of Kimberley. In fact, with respect to metallocene catalysts, Kimberley teaches that the alumoxane of Kimberley is to be effective with metallocenes and Chang's alumoxane is effective with metallocene by design. Furthermore, to the extent that a particular formulation of alumoxane by the method of Chang were less than optimal, both Kimberley and Chang teach that for a given catalyst system the alumoxane component should be optimized by choice of starting materials and formation conditions. Therefore, the alumoxane formed in situ by Chang would be expected to be suitable for the catalysts of Kimberley.

8. In view of the basis of the rejection, as summarized above, applicant's arguments starting at the bottom of page 6 of the Response with respect to Kimberley's addition of trialkylaluminum compound and with respect to whether the support of Kimberley was hydrated in the examples of Kimberley are not persuasive in traversing the rejection.
9. Applicant argues that Chang's disclosure suggests that the in situ method of Chang would only lead one of ordinary skill in the art to use that in situ method to make low molecular weight waxes. Kimberley relates to forming polyolefins and so does Chang. The claimed invention does not demand any particular molecular weight final product, and so this argument is not a basis for overcoming the rejection.

10. Applicant refers to the superior safety regime that results from in situ preparation.

That a superior safety regime may result appears to be correct. However, this quality does not appear to be unexpected as Chang refers to this quality. See Chang 0 323 716 A1 (page 6, lines 1-6).

11. In arguing unexpected results, applicant points to page 19 of the Specification, which includes Table 1. Applicant refers to the superior performance of Example 7 as compared to several comparative examples. It is unclear whether this superior performance can be expected over the breadth of the claimed invention. The superior results appear to be limited to one type of Fe compound of formula (I), to addition of one type of trialkylaluminum compound, to one degree of hydration of support, and to one monomer, among other factors. There is no apparent evidence that this improved performance is a general property since effectively only one example has been provided. Except for the use of TEA, no explanation for the different performance of Example 9 has been provided.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael La Villa whose telephone number is (571) 272-1539. The examiner can normally be reached on Tuesday, Thursday, and alternating Fridays.
13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael La Villa
9 December 2004

